The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN WILLIAMS

Appeal No. 2006-0913
Application 09/507,945[1]

ON BRIEF

Before BARRETT, BARRY, and BLANKENSHIP, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-6, 11, and 12. Claims 7-10 have been canceled.

We affirm-in-part.

[1] Application for patent filed February 22, 2000, entitled "Communication Terminal Having A Predictive Editor Application."

BACKGROUND

The invention relates to a communication terminal having a reduced keyboard, a first editor application communicating with a predictive editor program for generating matching words based on an ambiguous string of keystrokes, a language dependent dictionary, and a dictionary containing user defined inputs. Claim 1 additionally recites that the terminal has a second editor application for automatically copying words from a second memory means into the dictionary for user defined inputs. Claim 4 additionally recites a second editor application for entering key strokes in an unambiguous form (e.g., a multi-tap input system) used to revise, delete, and/or combine matching words generated by the first editor application.

Claim 1 is reproduced below.

1. A communication terminal having:

a display;

a keypad for use in the operation of said communication terminal having a plurality of keys associated with several letters each;

processor means controlling the display in accordance with the operation of the keypad;

a predictive editor program for generating an output containing word matching a received string of ambiguous key strokes, said predictive editor program having a number of associated vocabularies including at least one language dependent dictionary and at least one dictionary receiving user defined inputs stored in a first memory which serves said predictive editor program;

an editor application controlled by the processor means communicates with said predictive editor programs for generating matching words based on an ambiguous string of key strokes;

at least one applications program independent of said predictive editor program;

second memory means of the communication terminal independent of said first memory means for storing user inputted data in an electronic database, said second memory means serving said at least one applications program; and

wherein said processor means automatically searches said second memory means for words and copies these words into said at least one dictionary for receiving user defined inputs and associated with said predictive editor program.

THE REFERENCES

The examiner relies on the following references:

Schroeder et a. (Schroeder)	5,797,098	August 18, 1998
King et al. (King)	6,011,554	January 4, 2000
Frederiksen et al. (Frederiksen)	6,185,295	February 6, 2001 (filed February 18, 1998)

THE REJECTIONS

Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over King and Frederiksen.

Claims 4 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over King.

Claims 5, 6, and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over King and Schroeder.

We refer to the final rejection (pages referred to as "FR__") and the examiner's answer for a statement of the

examiner's rejection, and to the brief (pages referred to as "Br__") and reply brief (pages referred to as "RBr__") for a statement of appellant's arguments thereagainst.

DISCUSSION

Amendment to abstract

The examiner should indicate whether the amendment to the abstract is satisfactory. The Board's jurisdiction is limited to the rejection of claims.

Content of King

King discloses a disambiguating system with a reduced keyboard. A plurality of letters, numbers, and symbols are assigned to a set of data keys so that keystrokes entered by a user are ambiguous. Due to the ambiguity in each keystroke, an entered keystroke sequence could match a number of words with the same number of letters. The disambiguating system includes a memory having a number of vocabulary modules which contain a library of objects associated with a keystroke sequence, and objects within the vocabulary modules that match the entered keystroke sequence are identified by the disambiguating system. See abstract. The objects can be words, numbers, phrases, commands, etc. The system has a reduced keyboard 54 and a display 53 coupled to a processor 100 which is coupled to a memory 104. The memory contains disambiguating software 108,

associated vocabulary modules 110, and application programs, such as word processors and dictionaries. See Fig. 2; col. 6, lines 46-67. The vocabulary modules include standard modules for normal (letters) and numeric modes of operation (e.g., col. 10, lines 1-18 & 29-61), and a custom vocabulary module for receiving user defined inputs (col. 21, line 65, to col. 22, line 25), and entries from all modules can be put in the list or omitted (col. 15, lines 51-65). Thus, King discloses a display, a keypad, processor means, a predictive editor program (the disambiguating program) having at least one language dependent dictionary (dictionaries for letters and numbers) and one dictionary receiving user defined inputs (the custom dictionary), and an editor application (the part of the disambiguating software that generates matching words).

King discloses that the entered keystrokes may be interpreted in several different ways: (1) as a word using the disambiguating software to present words matching the input sequence of keystrokes (col. 7, line 19, to col. 8, line 24); (2) as a word stem (col. 8, lines 25-49); (3) each pair of keystrokes can unambiguously specify a single character using a two-stroke interpretation (col. 8, line 50, to col. 9, line 8); (4) a sequence of keystrokes can unambiguously specify a single character using a multiple-stroke interpretation (col. 9, lines 9-43); (5) as a number using the disambiguating software to

present words matching the input sequence of keystrokes (col. 9, lines 44-51); and (6) additional meanings such as a system command or system menu (col. 9, lines 52-67). Thus, King disclose six "editor applications," to use appellants' terminology, for generating matching objects based on a string of keystrokes.

Claims 1-3

The limitations at issue with claim 1 are an "application[] program independent of said predictive editor program; second memory means ... independent of said first memory means ..., said second memory means serving said at least one applications program; and wherein said processor means automatically searches said second memory means for words and copies these words into said at least one dictionary for receiving user defined inputs and associated with said predictive editor program." It appears that these limitations, taken together with dependent claims 2 and 3, refer to the description of storing names in a phone book on a SIM card and copying the data from the SIM card to the user directory at page 19, lines 12-19, of the specification.

The examiner's rejection states (FR3):

> King teaches the step of copying words into said at least one dictionary for receiving user defined inputs and associated with said predictive editor program from a variety of other sources that can be searched and downloaded to the dictionary (col. 22, lines 9-11). However, King does not explicitly disclose the source to be a second memory means of the communication terminal serving an independent

> application program for storing user inputted data in an electronic database wherein the memory is an electronic phonebook database stored on a Subscriber Identity Module (SIM) in a cellular phone. Frederiksen teaches a communication terminal comprising a phonebook database stored on an exchangeable SIM card that can be copied to the memory of the phone (col. 3, lines 47-49; fig. 4). It would have been obvious to an artisan at the time of the invention to combine Frederiksen's teaching with King's system in order to expand the dictionary to provide additional matching words.

Appellants state that "[t]he Examiner admits that King does not disclose the automatic entry of usable words in its predictive editor dictionary from other application software as required by claims 1-3 of Applicants' invention" (Br5). It is argued that Frederiksen merely exchanges the speed dialing status in a larger memory for that of a number in a speed dial location and the data is not processed in the second memory (Br6). It is argued that the examiner exaggerates that the memory of the SIM card can be copied to the memory of the phone because only a few numbers may be exchanged with numbers in the phone's speed dial system (Br6). It is argued that Frederiksen does not mention a predictive editor which can be automatically supplemented with words from an independent application memory (Br6). It is further argued that the examiner provides no motivation to make the combination and that even if the references are combined the combination would not teach the claimed invention (Br6-7).

The examiner responds that swapping means copying data from the SIM card location (element 11 of Fig. 4) to RAM memory

location (element 12 of Fig. 4) to be able to process and use that data of the SIM card (EA6). The examiner finds that the motivation is that it was well known that SIM cards and removable memory are used to expand the storage capability for additional matching words for greater flexibility and convenience (EA7).

Appellants respond that the swapping of two numbers in Frederiksen is significantly different than the searching of data in another application by a predictive editor processor (RBr2).

King teaches adding words from another source, such as from parsing documents to identify proper nouns or from other users' custom vocabularies, to the custom vocabulary module (col. 22, lines 8-20). The source is considered to correspond to an "applications program independent of said predictive editor program" and the memory the source words are stored in before being copied to the custom vocabulary is considered a "second memory means," as recited in claim 1, where the "second memory means" does not require a removable memory. King discloses that the "processor means ... copies these words [from the second memory] into said at least one dictionary for receiving user defined inputs and associated with said predictive editor program." What is not expressly taught by King is that the "processor means automatically searches said second memory means for words" before they are copied. Thus, the precise difference

between King and the subject matter of claim 1 is the "automatic" entry of usable words into the user defined vocabulary.

Frederiksen teaches a phone number database having a first group of memory locations with associated speed dialing facility (e.g., memory locations #1-#4 on the SIM card in Fig. 2) and a second group of memory locations without speed dialing facility (e.g., memory locations #65-#69 in Fig. 2) (col. 4, lines 3-18). Frederiksen discloses swapping the number in a location without speed dialing facility for a location with a speed dialing facility, e.g., storing the phone number for "John" in location #67 in memory location #2 presently occupied by "Gil" (col. 4, lines 12-18; col. 5, lines 14-17). Although the examiner finds that Frederiksen teaches copying from the SIM module to the internal RAM memory, we do not find this to be taught by Frederiksen. We read Frederiksen as swapping the contents of memory locations on the SIM card. There is no reason why the speed dial locations cannot correspond to the first locations on the SIM card or why phone numbers have to be loaded into the RAM to work since a SIM is just a type of memory. In addition, even if names and numbers were stored into the RAM, Frederiksen does not teach that the "processor means automatically searches said second memory means for words and copies these words into said at least one dictionary for receiving user defined inputs" because the user must manually select telephone numbers to be stored.

Therefore, we do not see how Frederiksen can teach the automatic entry of usable words. We conclude that the examiner has failed to establish a prima facie case of obviousness and, therefore, the rejection of claims 1-3 is reversed.

Claims 4-6, 11, and 12

The issue with claim 4 is the limitation of "a second editor application controlled by said processor means for entering key strokes in an unambiguous form; wherein said second editor is used to revise, delete, and/or combine said matching words generated by said first editor application." We interpret "revise, delete, and/or combine" to be met by any one of the functions because the word "or" signifies alternative functions. This limitation refers to using the multi-tap spell mode when no possible matches are found using the predictive editor, as noted in the specification, page 21, line 23, through page 22.

The examiner finds that King teaches an editor application for entering words in an unambiguous form but does not explicitly disclose that the editor is used to revise, delete, and/or combine words (FR4). The examiner takes Official Notice that managing operations for user-defined lists was well known and the examiner concludes that it would have been obvious to include managing operations in King to maintain the user-defined lists of words (FR4-4). The examiner states in the answer (EA7): "King

clearly shows the Editing words capability (col. 19 line 65 - col. [20, line] 39, col. 22, lines 27-44, figs 8A-D, and 11-12."

Appellants argue that the examiner's Official Notice is unsupported by any reference and does not address the limitations of the second editor application (Br8). It is argued that the use of the second editor application to remove or maintain words entered using the second editor application is not disclosed or suggested by King (BR9).

King discloses that the output of the disambiguating system is generally provided to other application programs controlled by the processor (col. 21, lines 51-56), which program may be a word processor (col. 6, lines 62-64). A word processor application is considered to have (or at least suggest to one skilled in the art) elementary word processing functions, such as revising and deleting words and letters, and also removing or maintaining words, as recited in claim 12. The word processor is considered a "second editor application" which is used to revise, delete, and/or combine matching words generated by the predictive editor, and suggests to one of ordinary skill in the art that the output of the predictive editor can be edited by the word processor using any of the techniques in King, including the unambiguous multi-tap character entry mode. Moreover, King does not state that the word processor is limited to the restricted keyboard and it could use a standard unambiguous keyboard as, for example,

when the disambiguating system with the reduced keyboard is used with a conventional computer as shown in Fig. 10.

King discloses an "edit" mode in which words generated by the predictive editor can be edited (col. 19, line 65, to col. 20, line 39). The edit mode is considered to be a "second editor application." The key map 800 (Fig. 6) indicates data key functions which are unambiguous. Unfortunately, King does not explain the "edit keys" on the key map and, while King states that "the user has several different options for editing the word" (col. 20, line 22), King only mentions selecting a word from the interpretation list (col. 20, lines 25-30). Nevertheless, selecting an alternative word from the list using an unambiguous "select" key is considered to "revise" the word, as recited in claim 4. In addition, words can be "deleted" by selecting the system command "<cancel>" from the selection list 76 in the edit mode, where "<cancel>" cancels the current key sequence (col. 9, lines 57-59). Thus, the edit mode also satisfies the "second editor application" limitation.

King discloses a "respell" mode which allows a user to disambiguate an ambiguous keystroke sequence which has been entered by the predictive editor, but which does not match any word in the vocabulary (col. 20, line 40, to col. 21, line 5). However, what is being revised is a sequence of keystrokes and not a recognized word.

We conclude that the "second editor application" of claim 4 is taught, or at least suggested to one skilled in the art, by the word processor and the "edit" mode in King. Accordingly, it is not necessary to rely upon the examiner's Official Notice; it is not clear how the examiner's finding that managing operations for user-defined lists was well known helps in deciding the issue of the "second editor application." The word processor of King also suggests to one of ordinary skill in the art "means adapted to remove or maintain words entered using said second editor application," as recited in claim 12, because word processors must have these functions. The rejection of claims 4 and 12 is affirmed. The patentability of claims 5, 6, and 11 has not been separately argued and, hence, the rejection of claims 5, 6, and 11 is also affirmed.

CONCLUSION

The rejection of claims 1-3 under 35 U.S.C. § 103(a) is reversed, while the rejections of claims 4-6, 11, and 12 under § 103(a) are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1). See 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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